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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,618	12/07/2004	Steven Melvyn Howdle	P70039USD	4009

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WASHINGTON, DC 20004

EXAMINER

HELM, CARALYNNE E

ART UNIT	PAPER NUMBER
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1615

MAIL DATE	DELIVERY MODE
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12/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/506,618

Applicant(s)

HOWDLE ET AL.

Examiner

CARALYNNE HELM

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-59 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 25-59 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/55/08)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

The previous restriction requirement is hereby withdrawn. The current restriction requirement is applied to further clarify the restriction groups.

Election/Restrictions

Restriction

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 25-27, 29, 33, 37, 39, 40, 42, 45, 49, 53, 55, and 56, drawn to the particulars regarding the deposit.

Group II, claim(s) 25-26, 28, 30, 33, 37, 41-44, 46, 49, 53, and 57, drawn to the particulars regarding the polymer substrate.

Group III, claim(s) 25-26, 31, 33, 37, 42, 47, 49, and 53, drawn to the particulars regarding the absence of a solvent.

Group IV, claim(s) 25-26, 33-37, 38, 42, and 49-54, drawn to the particulars of the plasticizing fluid/conditions.

Group V, claim 25-26, 33, 37, 42, 49, 53, and 58, drawn to a polymer composite.

Claim 59 has not been included in a restriction or listed as a linking claim because it is constructed as a "use" claim which is non-statutory subject matter. Should

applicant amend this claim to be drawn to process or product not included in the groups delineated above, it would form its own separate group.

The inventions listed as Groups I-V do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical feature common in all the groups is a process for the preparation of a polymer composite comprising internally distributed deposition matter wherein the process comprises providing a deposit of deposition matter at the surface of a solid state polymer substrate by fluid phase deposition of discrete particles or dissolved deposition matter by immersion or spraying of solid state polymer substrate with a solution, dispersion or suspension of deposition matter, drying by freezing, evaporation, heating or blotting, and impact effects contacting the surface deposited polymer with a plasticizing fluid or a mixture of plasticizing fluids under plasticizing conditions to plasticize and/or swell the polymer and internally distribute deposition matter, and releasing the plasticizing fluid or fluids to obtain polymer composite. This element cannot be considered a special technical feature under PCT Rule 13.2 because it is shown in prior art. The Liquid State Activation Reference (XP002142912 – see IDS) teaches this process where a polymer substrate is contacted with a drug solution such that the polymer swells and absorbs the drug. Subsequently the polymer is contacted with a supercritical fluid which plasticizes the polymer. This plasticizing fluid is then

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removed for the polymer resulting in the formation of polymer with internally deposited matter.

Election

This application also contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

Processes of preparation with a particular method of deposition (select one)

A: dissolved/dispersed deposition by immersion

B: dissolved/dispersed deposition by spraying

Should Group I be elected, then the species election also includes a particular deposition matter (select one – see claims 39, 40, 55, and 56 for options)

Should Group II be elected then the species election also includes a particular polymer (select one - see claims 41 and 57 for options)

Should Group IV be elected then the species election also includes a particular plasticizing fluid (select one - see claim 38 and 54 or options)

Should Group V be elected then a particular polymer and deposit material must also be elected.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the same reasons cited above.

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The following claim(s) are generic: claims 25-59

Examiner notes that a proper election would include an invention group as well as a species with a particular method of deposition. If group I, II, IV or V is elected, then the additional corresponding election as detailed above is required.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CARALYNNE HELM whose telephone number is (571)270-3506. The examiner can normally be reached on Monday through Thursday 8-5 (EDT).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward or Tracy Vivlemore can be reached on 571-272-8373 or 571-272-2914, respectively. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Caralynne Helm/
Examiner, Art Unit 1615

/Tracy Vivlemore/
Primary Examiner, Art Unit 1635